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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,159	12/23/2005	Heinz Metzger	49727	6588
1609 7590 05/18/2009 ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036				
EXAMINER				
REESE, DAVID C				
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3677				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/562,159

**Applicant(s)**

METZGER, HEINZ

**Examiner**

David C. Reese

**Art Unit**

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-25 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-21, and 24-25 is/are rejected.
- 7) ☒ Claim(s) 22 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 2/5/2009.

- Claims 1-10 were canceled.
- Claims 11-25 were added.
- Claim 18 is withdrawn (see below).
- Claims 1-25 are pending.

#### ***Election/Restrictions***

[1] Newly submitted claim 18 is directed to an invention that is independent or distinct from the elected invention for the following reasons: it is directed toward the species found in figs. 3-4 (head being countersunk); not the elected species of figures 1-2. Accordingly, claim 18 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Drawings***

[2] The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plural tensioners from claim 13; said tensioners comprising set screws uniformly distributed over a circle from claim 17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

[3] The abstract of the disclosure is objected to because of its length. The abstract should only be between 50 and 150 words. Correction is required. See MPEP § 608.01(b).

***Claim Objections***

[4] Claim(s) were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 2/5/2009. Accordingly, the objection(s) to the claim(s) have been withdrawn.

***Claim Rejections - 35 USC § 102***

[5] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for

patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

[6] Claims 11-12, 19, and 25 are rejected under 35 U.S.C. 102(b) as anticipated by Manfred, US-6,851,905, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 11, Manfred discloses of a threaded ring for threadedly engaging an externally threaded section of a spindle, comprising:

a one-piece body (2) having first (3) and second (1) body components relatively movable between a preinstallation state (fig. 2) and an installation state (fig. 3) and having a longitudinal axis, each of said body components having an internal thread (7, 10) forming a threaded flank clearance in the preinstallation state, said first body component (3) forming a set collar with a planar surface on one end thereof extending in a radial plane relative to said longitudinal axis, said second body component (1) forming a retaining ring connected to said first body component and having a contact surface extending non-perpendicularly relative to said longitudinal axis and at an angle of inclination from a plane perpendicular to said longitudinal axis in the preinstallation state, said threaded flank clearance being eliminated in the installation state;

a gap (see L) between said body components;

an elastically flexible wall (around 2) component of said body connecting said body components; and

an actuator (8) engaging said contact surface to adjust geometry of said gap by adjustment of said flexible wall along said longitudinal axis and by movement of said body components between said states.

Re: Claim 12, wherein the contact surface extends perpendicular to said longitudinal axis in the installation state (see fig. 3).

Re: Claim 19, wherein said first (3) and second (1) body components have equal outside diameters.

Re: Claim 25, wherein said contact surface is planar.

[7] Claims 11-17 and 22-25 are rejected under 35 U.S.C. 102(b) as anticipated by Harbottle et al., US-5,662,445, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 11, Harbottle et al. discloses of a threaded ring for threadedly engaging an externally threaded section of a spindle, comprising:

a one-piece body (n) having first (60) and second (56) body components relatively movable between a preinstallation state and an installation state and having a longitudinal axis, each of said body components having an internal thread (52) forming a threaded flank clearance in the preinstallation state, said first body component (60) forming a set collar with a planar surface on one end thereof extending in a radial plane relative to said longitudinal axis, said second body component (56) forming a retaining ring connected to said first body component and having a contact surface (88 in fig. 6) extending non-perpendicularly relative to said longitudinal axis and at an angle of inclination from a plane perpendicular to said longitudinal

axis in the preinstallation state, [said threaded flank clearance being eliminated in the installation state]\*;

a gap (72) between said body components;

an elastically flexible wall (78) component of said body connecting said body components; and

an actuator (84) engaging said contact surface to adjust geometry of said gap by adjustment of said flexible wall along said longitudinal axis and by movement of said body components between said states.

Examiner's note\*: the above statement in brackets is an example of intended use, functional language that fails to further limit the structure of the claimed invention. The prior art needs to only be capable of performing said functional recitation in order to be applicable and in the instant case, the prior art of Harbottle et al. is indeed capable of eliminating the flank clearance at some point during the threading of the fastener through the ring. Note that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Re: Claim 12, wherein the contact surface extends (88 in fig. 7) perpendicular to said longitudinal axis in the installation state.

Re: Claim 13, wherein said actuator (84) comprises plural tensioners (84) permitting modification of widths of said gap at selected points (see figs. 3 and 5).

Re: Claim 14, wherein said contact surface is situated between said tensioners (84) and said second body component (56).

Re: Claim 15, wherein a part of said contact surface is assigned to each of said tensioners (84).

Re: Claim 16, wherein said second body component (56) comprises recesses (86) receiving said tensioners (84).

Re: Claim 17, wherein said tensioners (84) comprise set screws (84) uniformly distributed over a circle coaxial to said longitudinal axis, said set screws penetrating said gap parallel to said longitudinal axis, and having screw heads supported on said contact surface in the installation state (see figs. 3 and 5).

Re: Claim 20, wherein said angle of inclination is one-half to five degrees.

Re: Claim 21, wherein said angle of inclination is one to three degrees.

Re: Claim 24, wherein said angle of inclination is an acute angle.

Re: Claim 25, wherein said contact surface is planar.

***Allowable Subject Matter***

[8] Claims 22-23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

[9] Applicant's amendment, see amendment and remarks filed 2/5/2009, with respect to the rejection(s) of claim(s) under Gall, have been fully considered. Therefore, the rejection with regard to Gall has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Manfred, US-6,851,905; then Harbottle et al.,



US-5,662,445. Consequently, all arguments are considered moot to said new grounds of rejection. Please also note the additional notice of reference cited.

***Conclusion***

[10] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[11] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese

/D. C. R./  
Examiner, Art Unit 3677

/Victor Batson/  
Supervisory Patent Examiner, Art Unit 3677